

REMARKS

Claims 1, 11, 13-17, 37-41 and 43-48 are presently pending. Of these, Claims 11 and 45-48 are withdrawn from consideration. Support for amendments to Claims 1, 13, 39, 40, 45 and 46 is found in the Specification as filed, for example at page 9, lines 22-26. No new matter has been added herewith.

The Patent Office indicated that Claims 42-44 would be allowable if rewritten in independent form, including all the limitations of the base claim and any intervening claims. As discussed below, amended Claim 41 is believed to be in compliance with 35 U.S.C. § 112, second paragraph and therefore should also be allowable. Accordingly, Applicants have amended Claims 42-44 to be dependent on Claim 41. Thus, Claims 41-44 are believed to be allowable.

The following addresses the substance of the Office Action.

Priority

The Patent Office has indicated that a certified copy of each foreign priority document, in Japanese, has been received and that no English translations have been provided. According to MPEP 201.13, an English language translation of a non-English language foreign application is not required except: (A) when an application is involved in an interference, (B) when necessary to overcome the date of a reference relied upon by the examiner, or (C) when specifically required by the examiner. Since none of these conditions presently exist in the subject application, the Applicant does not need to submit an English translation of the foreign priority documents at this time.

Indefiniteness

Claim 41 was rejected under 35 U.S.C. § 112, second paragraph as being indefinite. In particular, the Examiner found that the compounds “6-O-decenoyl arbutin,” “6-O-oleoyl arbutin,” “6-O-benzoyl arbutin,” “6-O-butanoyl arbutin,” “6-O-lauroyl arbutin,” and “6-O-stearoyl arbutin” are no longer encompassed by Claim 1 in view of the previous amendments to Claim 1, and thus there was no antecedent basis for these specific compounds. The Applicant notes that, in contrast to the Examiner’s assertion, “6-O-decenoyl arbutin” meets the first definition of Ra (i.e., when Ra is $R_1\text{-CH=CH}_2$, wherein R_1 is a single bond, an unsubstituted alkyl group or an arylene group). Thus, Applicant does not believe that it is necessary to delete recitation of “6-O-decenoyl

arbutin". Nevertheless, to expedite prosecution of the application, Applicant has amended Claim 41 to be in independent form, thereby obviating the rejection.

Anticipation

Claims 1 and 37-40 were rejected under 35 U.S.C. § 102(b) as being anticipated by Takido et al. (1983 *Phytochemistry* **22**:223-225). Takido et al. disclose phlebotrichin, a phenolic glucoside. However, the Applicants previously pointed out that the compound disclosed by Takido et al. contains a hydroxyl group, which is not included in the compounds defined in Claim 1. The Examiner was not persuaded by this argument and stated that, the limitation $R_1 \text{ CH=CH}_2$, wherein R_1 is a single bond, an alkyl group or an arylene group does not specifically limit the alkyl group to any substitution or non-substitution.

The Applicant believes that the Examiner misstated the definition of alkyl. Nevertheless, in light of the description in the specification that alkyls can be substituted or unsubstituted, Applicant has amended Claim 1 to specifically recite that, in the first definition of R_a , R_1 is a single bond, an unsubstituted alkyl group or an arylene group. In view of this amendment, the compounds disclosed by Takido et al. do not anticipate the claims. Accordingly, the Applicant respectfully requests that the rejection under 35 U.S.C. § 102(b) be withdrawn.

Obviousness

Claims 13-17 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Takido et al. (*supra*) in view of WO 2001/79241 to Weiss et al., in further view of Kiyoshi et al. (JP 2001-151623) and Gordon et al. (The Chemist's Companion, A Handbook of Practical Data, Techniques, and References, John Wiley & Sons, 1972, New York, page 447). The Examiner stated that it would have been obvious to one of ordinary skill in the art to arrive at the presently claimed processes by combine the teachings of Takido et al., concerning phlebotrichin, a phenolic glucoside, with the teachings of Weiss et al., regarding biologically active glycoside esters of arbutin or other monosaccharides, with the teachings of Kiyoshi et al., regarding the preparation of a skin lotion and Gordon et al, which discloses that molecular sieves function as a general-purpose drying agent.

Applicant has amended Claim 13 in a manner similar to the amendment made to Claim 1, wherein when arbutin is esterified with the carboxylic acid: $A\text{-OCO-R}_1\text{-CH=CH}_2$, wherein R_1 is a single bond, an unsubstituted alkyl group or an arylene group. Accordingly, the compounds that

are produced by amended process Claims 13-17 are novel over Takido et al. Weiss et al., Kiyoshi et al. and Gordon et al. do not teach the presently claimed compounds or methods of making them. Accordingly, the additional references fail to fill the gap between the presently claimed processes and Takido et al. Moreover, the inventors have surprisingly shown that the claimed compounds demonstrate tyrosinase inhibitory activity. In particular, as described in Applicants' specification at page 26, lines 28-33, the claimed compounds exhibit inhibitory activity against both catechol and phenol substrates in contrast to arbutin itself. There was no reason for one of ordinary skill in the art to believe that the presently claimed processes would produce arbutin esters that demonstrate tyrosinase inhibitory activity. Such unexpected results are further evidence that the presently claimed processes are not obvious.

In view of the foregoing, the Applicant respectfully requests that the rejection under 35 U.S.C. § 103(a) be withdrawn.

No Disclaimers or Disavowals

Although the present communication may include alterations to the application or claims, or characterizations of claim scope or referenced art, Applicant is not conceding in this application that previously pending claims are not patentable over the cited references. Rather, any alterations or characterizations are being made to facilitate expeditious prosecution of this application. Applicant reserves the right to pursue at a later date any previously pending or other broader or narrower claims that capture any subject matter supported by the present disclosure, including subject matter found to be specifically disclaimed herein or by any prior prosecution. Accordingly, reviewers of this or any parent, child or related prosecution history shall not reasonably infer that Applicant has made any disclaimers or disavowals of any subject matter supported by the present application.

CONCLUSION

In view of Applicants' amendments to the Claims and the foregoing Remarks, it is respectfully submitted that the present application is in condition for allowance. Should the Examiner have any remaining concerns which might prevent the prompt allowance of the application, the Examiner is respectfully invited to contact the undersigned at the telephone number appearing below.

Application No.: 10/530,789
Filing Date: April 8, 2005

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: February 5, 2010

By: /Raymond D. Smith/

Raymond D. Smith
Registration No. 55,634
Agent of Record
Customer No. 20995
(949) 760-0404

8500941
020410